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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,663	09/07/2000	Joseph E. Kaminkow	0112300/012	1991
29159	7590	02/17/2004	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			JONES, SCOTT E	
			ART UNIT	PAPER NUMBER
			3713	20
DATE MAILED: 02/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/656,663

Applicant(s)

KAMINKOW ET AL.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 131-161, 167-203, 207, 208, 210-216, 220 and 221 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 153-161, 188-196, 207, 208, 220 and 221 is/are allowed.
- 6) ☒ Claim(s) 131-152, 167-187, 197-203, and 210-216 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on December 4, 2003 in which applicant amends claims 131-135, 138, 139, 142, 143, 147, 150, 153, 156, 159, 167-171, 174, 177, 178, 182, 185, 188, 191, 194, 197-199, 201, 202, 207, 208, 210, 211, 214, 215, 220, and 221, cancels claims 162-166, 204-206, 209, and 217-219, and responds to the claim rejections. Claims 131-161, and 167-203, 207, 208, 210-216, and 220-221 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 147-152 and 182-187 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsukahara (U.S. 6,416,411).

Tsukahara discloses a gaming machine having random sound effects so that a player does not become bored playing the same game (Abstract, figures 3, 5, 6, and column 2, lines 26-57).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 131-146, 167-181, 197-203, and 210-216 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss (U.S. 6,309,299) in view of Lebensfeld et al. (U.S. 6,311,982).

Weiss discloses a traditional gaming machine enhanced and blended with a battleship game.

Weiss additionally discloses:

Regarding Claims 131, 142, 167, 177, 197, 199, 202, 210, and 212-215:

- operating a game upon a wager by a player (Figure 5 and column 3, lines 34-48);
- displaying a target/pitfall (ships located on the x-y grid) (Figure 1);
- displaying a plurality of non-targets/non-pitfalls (grid locations c-2 and e2) including at least two non-targets/non-pitfalls which are each a same predetermined proximity/distance from said target/pitfall (Figure 1);
- selecting either said target/pitfall or one of the non-targets/non-pitfalls (Figure 2 and column 2, lines 15-24); and
- generating a sound effect associated with said predetermined proximity/distance when one of said non-targets/non-pitfalls selected is within said predetermined proximity/distance (Column 4, lines 19-20).

Regarding Claims 132 and 168:

- the non-targets/non-pitfalls which are within said predetermined proximity from said target are spatially related to said target (Figure 1). Grid locations c-2 and e2 are each one space away from the target.

Regarding Claims 133 and 169:

- the non-targets/non-pitfalls which are within said predetermined proximity from said target are numerically related to said target (Figure 1).

Regarding Claims 134 and 170:

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- at least one non-target/non-pitfall within said predetermined proximity from said target/pitfall is located numerically above said target/pitfall, and at least one non-target/pitfall within said predetermined proximity from said target/pitfall is located numerically below said target/pitfall (grid locations c-2 and e2) (Figure 1).

Regarding Claims 135, 143, 171, 178, 198 and 211:

- said sound effect includes a message describing the location of said target/pitfall (Column 2, lines 20-24).

Regarding Claims 136 and 172:

- the plurality of non-target/non-pitfall includes at least one non-target/non-pitfall (32) which does not have an associated sound effect (Figure 1).

Regarding Claims 137, 173 and 200:

- providing an award to a player when said target/pitfall is selected (Figure 3 and column 2, lines 15-24).

Regarding Claims 138, 174, and 201:

- the processor causes the speaker to generate a second different sound effect when said target is selected (Column 4, lines 18-20). Bombs in flight will sound different than a bomb in flight that lands and hits a target.

Regarding Claim 139:

- the processor causes the speaker to generate a third different sound effect when said award is provided to the player. Inherently, bells, chimes, dings, sirens, or some other form of sound is used in the game machine to indicate a win.

Regarding Claims 140 and 175:

- the target or one of the non-targets is processor selected (Column 2, lines 1-25).

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Regarding Claims 141 and 176:

- the target or one of the non-targets is player selected (Column 5, lines 32-46).

Weiss seems to lack explicitly disclosing:

Regarding Claims 131, 142, 144, 167, 177, 179, 197, 203, 210, 212-215, and 216:

- a second sound effect, which is different from the first sound effect associated with said second predetermined proximity.

Lebensfeld et al., like Weiss, teaches of an electronic game. In particular, Lebensfeld et al. teaches of a “hot/cold” or “near/far” type hide and find toy game. As a player gets closer to the toy a stronger audible signal is generated to a player’s receiver and vice versa (Column 2, line 50-Column 3, line 67). It would have been obvious at the time of applicant’s invention to incorporate the traditional “hot/cold” children’s game feature in Weiss’ battleship game. One would be motivated to do so because this would enable a player playing Weiss’ game to have a better idea of where a ship is located to fire the next missile, etc.

Allowable Subject Matter

6. Claims 153-161, 188-196, 207, 208, and 220-221 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record lacks disclosing, teaching, or fairly suggesting “counting the number of times one of the non-targets is selected, and upon reaching said predetermined number, causing the speaker to generate: (a) one of said sound effects when one of the non-targets is selected; and (b) another one of the sound effects associated with a different one of the proximities when another one of the non-targets is selected.

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Response to Arguments

8. Applicant's arguments filed December 4, 2003 with respect to claims 131-146, 162-166, 167-181, 197-203, 210-211, and 215-216 have been fully considered but they are not persuasive.

9. Applicant disagrees with the rejection to Claims 131-143, 162-166, 167-178, 197-202, 210-211, and 215 under 35 U.S.C. 102(e) as being anticipated by Weiss (U.S. 6,309,299). However, Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection and the amendment of the claims. Please see the rejection to the claim in item No. 5.

10. Applicant disagrees with the rejection to claims 147-152, 182-187, 204-205, 209, and 217-218 under 35 U.S.C. 102(e) as being anticipated by Tsukahara (U.S. 6,416,411). Applicant alleges Tsukahara does not disclose a target or a non-target. However, the examiner respectfully disagrees. A target is a winning combination of symbols obtained on the reels of a slot machine, whereas, a non-target is a losing combination of symbols obtained on the reels of a slot machine. Therefore, the examiner believes Tsukahara anticipates the claims.

11. Applicant disagrees with the rejection to claims 144-146, 179-181, 203, and 216 under 35 U.S.C. 103(a) as being unpatentable over Weiss (U.S. 6,309,299) in view of Lebensfeld et al. (U.S. 6,311,982). Applicant alleges Weiss and Lebensfeld are incompatible because Lebensfeld is related to a "toy set for children" and Weiss is directed to "wagering in a casino environment." The examiner respectfully disagrees. First, Lebensfeld is directed to hide and find/hot and cold toy game. Weiss is directed to a hide and find type battleship game. Therefore, as previously stated, it would have been obvious at the time of applicant's invention to incorporate the traditional "hot/cold" children's game feature in Weiss' battleship game. One would be motivated to do so because this would enable a player playing Weiss' game to have a better idea of where a ship is located to fire the

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next missile, etc. Therefore, the examiner believes the combination of Weiss and Lebensfeld render the claimed invention obvious.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones
Examiner
Art Unit 3713



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